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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/896,004	06/29/2001	Aruna Nathan	ETH-1572	1514

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EXAMINER
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LEVY, NEIL S

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 03/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

Applicant(s)

Examiner

Group/Art Unit

10

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 10/30/02
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 32-48, 57 is/are pending in the application.
- Of the above claim(s) 36, 37, 41, 46, 47 is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 32-35, 38-40, 42-45, 48 & 57 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☒ Claim(s) 32-48, 57 are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4, 8
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

Office Action Summary

Art Unit: 1616

8.25.01 is wrong

Claims 36, 37, 41, 46, 47 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 9.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 32-35, 38-40, 42-45, 48 and 57 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Effective amount is not specified as to what effective for, in terms of desired projection. The derivatives should be identified, as examiner fails to find limitation of any particular form – we don't know how much of an acid moiety is considered by applicant to constitute a derivative – OK? Claim 38 appears to have a misprint, as it would seem unlikely that the 100,000 N product would be a wax melting below 70°C. "other diols" render claim 43 indefinite.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 32, 33, 44 and 57 are rejected under 35 U.S.C. 102(a,e) as being anticipated by Redding et al 6110501.

Any active pharmaceutical (col. 5, A) in amounts effective dosage forms in incorporating a microcapsule are disclosed, with shells of wax derived from vegetables or animals (col. 4, lines 16-23) including the exemplified palmitic oil waxes, and vegetable derived fats and waxes, therefore of less than 70° M.P. (See experiment 1-MP about 57%) regardless of how determined. Since claimed is a composition no patentable weight is given to the process of making or the origin. Neither chance been shown by applicant to be critical parameters. The elected species of active is not specified; any drug will do however.

Claims 32, 33, 35, 38, 44, 48 and 57 are rejected under 35 U.S.C. 102(b) as being anticipated by Fues et al 5308623.

Big compatible waxes of glycidic and lactic acids (col. 3, lines 17-68) inclusive of bioactive agents chemotherapeutics, Ca, Mg, to promote bone growth are shown, advantageously enhanced (col. 4, lines 46-63) with incorporation of glycerol or glycerol partial esters. Enhanced forms permit of adjustment of molecular weight, and melting point (col. 5, lines 53-66), within the ranges instantly claimed, fatty acid glycerol esters are utilized from 8-20 carbon chain acids (col. 5, lines 13-18).

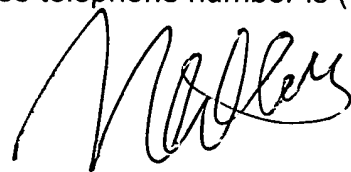
Claims 32-35, 38, 40, 42, 44, 57 are rejected under 35 U.S.C. 102(b) as being anticipated by Iyengar et al 5360626.

lyengar provides the instant polymeric compositions, of branched copolymeric forms, of reaction products of polyols, fatty acids and polybasic acids (col. 3, lines 65-col. 3, line 50), with the particular molecular weight and desired properties a function of the starting materials, these include the instant acids – citric, succinic and corresponding anhydrides (lines 40-43) with the usual vegetable fatty acids (lines 45, 46, col. 4, lines 57-60). Oboic, palmitoleic, stearic. A branched forms with copolymer in shown at fig. 3; using monoglycerid. The instant molecular weight range is shown (col. 4, lines 42-43). Melting temperation are 37-40% (col. 5, lines 31-36). Bioactives incorporated include naturally derived proteins milks-solids antidiuretics, salt (example 1).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neil Levy whose telephone number is (703)308-2412. The examiner can normally be reached on Tuesday through Friday 7 AM to 5:30 Pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jose Dees can be reached on (703) 308-4628. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.



NEIL S. LEVY  
PRIMARY EXAMINER